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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,001	12/10/2001	Ynjiun P. Wang	T075A	3855

7590 08/29/2002

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EXAMINER

JEANTY, ROMAIN

ART UNIT

PAPER NUMBER

3623

DATE MAILED: 08/29/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/016,001

Applicant(s)

WANG ET AL.

Examiner

Romain Jeanty

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 5-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-15 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 1-4, drawn to a method of capturing and providing demographic information concerning a consumer of products to a manufacturer of such products during transactions in which the consumer utilizes a bar code reader and the Internet for product inquiries, classified in class 705, subclass 10.

Group II. Claims 5-12, drawn to a method for a consumer to obtain produce information, classified in class 705, subclass 10.

Group III. Claims 13-15, drawn to a method for obtaining consumer demographic information, classified in class 709, subclass 238.
2. The inventions are distinct, each from the other because of the following reasons
Inventions I, II and III are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as providing the associated web site address to a computing device of the consumer for allowing the consumer to make a product information inquiry to said web site address. In the instant case, invention II has separate utility such as transmitting Transmission Control Protocol/Internet Protocol (TCP/IP) packet information to a Mapping Service Provider. In the instant case, invention III has separate utility such as employing cross application to a Domain Name System (DNS) to translate Internet Protocol (IP) mapping information to the destination Internet address to allow obtaining of demographic information associated with each product query (MSP). See MPEP § 806.05(d).

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Newly submitted claims 5-15 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 5-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al (U.S. Patent No. 5,978,773) in view of Powell (U.S. Patent No. 5,887,271).

As to claims 1 and 3, Hudetz discloses:

Providing the customer with a bar code symbol reader (Col. 5, lines 1-5).

Scanning a uniform product code (UPC) bar code symbol (col. 8, lines 38-43); and

Providing an associated table in a database between the UPC symbol data and an Internet web site address affiliated with the product manufacturer (Col. 7, lines 17-28 and Col. 7, lines 64 through Col. 8, line 10);

Providing the associated web site address to a remote computing device of the consumer for allowing the consumer to make a product information inquiry to said web site address (e.g., displaying a web page having a URL for the user to click on to make a product inquiry)(Col. 7, lines 45-57). Hudetz does not explicitly disclose providing demographic information about the consumer to the product manufacturer by utilizing the information inquiry. Powell on the other hand, discloses a system for locating products which upon completing a transaction in which one more incentives is received and a redemption data which includes customer ID data which infers that this demographic data has been provided to the manufacturer (col. 7, lines 1-7). It would have been obvious to a person of ordinary skill in the art to modify the Hudetz's system to include providing the demographic information to a manufacturer as evidenced by Powell. The motivation being to facilitate the manufacturer to optimize his marketing program through utilization of more accurate targeting.

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As per claim 2, Hudetz et al discloses the bar code reader being provided at the user's terminal (see figure 1).

7. Claims 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al and Powell as applied to claim 1 above, and further in view of Kaplan (U.S. Patent No. 5,963,916).

As per claim 4, as proper and understood by the examiner, Hudetz et al and Powell does not explicitly disclose providing targeted e-mails to the consumer for product announcements by the manufacturer. Kaplan on the other hand, discloses sending a product notification to a user. Note column 16, lines 16-26. It would have been obvious to a person of ordinary skill in the art to modify Hudetz et al and Powell by including an e-mail notification as taught by Kaplan. The motivation being to encourage a user to purchase certain desired products from the manufacturer thereby increasing marketing sales for the manufacturer.

Response to Argument

8. Applicant's arguments with regard to claims 1-4 have been considered but are moot in view of the new ground of rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed Romain Jeanty whose telephone number is (703) 308-9585. The examiner can normally be reached Monday-Thursday from 7:30 am to 6:00 pm.

If attempts to reach the examiner are not successful, the examiner's supervisor, Tariq R Hafiz can be reached at (703) 305-9643.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C 20231

or faxed to:

(703) 305-7687

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington VA, seventh floor receptionist.

August 24, 2002

Romain Jeanty

Patent Examiner

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